

REMARKS

This paper responds to the Office Action mailed December 18, 2006. Claims 1-8, 15-20, and 55-86 were pending and claims 1-8, 15-20, and 55-72 were under consideration in connection with the present application. In this paper, claims 1, 6, 7, 18, 19, 63, 66, 70, 73, 76, and 80 are amended, and no claims are cancelled or newly presented for consideration. Accordingly, claims 1-8, 15-20, and 55-86 remain pending and claims 1-8, 15-20, and 55-72 remain under consideration.

I. The Amendments to the Claims

This paper presents an amendment to claims 1, 6, 7, 18, 19, 63, 66, 70, 73, 76, and 80. The amendments to claims 1, 6, 7, 17, 18, 19, 63, 66, 70, 73, 76, and 80 are fully supported by the application as filed. Accordingly, the amendments to the claims present no new matter.

In particular, the amendments to claims 1, 6, 7, 18, 19, 63, 66, 70, 73, 76, and 80 are supported by the originally filed versions of the amended claims, as the sole change presented by each of the amendments to the claims is to delete members of a Markush group, with one exception. As the application as filed describes the entire Markush group, it necessarily describes the portion of the Markush group recited by the amended claims. *See See In re Johnson* 558 F.2d 1008, 1019, 194 U.S.P.Q. 187, 196 (C.C.P.A., 1977). In addition, Applicants have replaced the (C₁-C₆)alkylene group recited by claims 1, 63, and 73 with a -CH₂- moiety. This amendment is supported by, for example, claim 6 as filed and the specification at paragraphs 16 and 38 (in the version of the application published as U.S. Patent Application Publication No. 20040248882). Accordingly, the amendments to the claims are fully supported by the application as filed and introduce no new matter.

In addition, entry of the amendments to the claims after final rejection is believed proper because the amendments narrow the issues remaining and therefore present the claims in better form for consideration on appeal. Entry of the amendments to the claims is therefore respectfully requested pursuant to 37 C.F.R. § 1.116..

II. Restriction

Claims 73-86 stand withdrawn as directed to a non-elected invention and relate to methods for modulating conditions or disorders associated with metabolic or inflammatory disorders. Applicants respectfully remind the PTO that claims 73-86 are method claims that recite all the limitations of the compounds encompassed by, for example, claim 1. As such, Applicants respectfully submit that withdrawn method claims 73-86 should be rejoined after

the compound claims presently under examination are deemed allowable by the PTO. *See* M.P.E.P. § 821.04(b).

III. The Rejection of Claims 1-8, 15-20, and 55-72 as Failing to Comply with the Enablement Requirement of 35 U.S.C. § 112, First Paragraph Should be Withdrawn

Claims 1-8, 15-20, and 55-72 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Without acquiescing to the propriety of the rejection, and solely to expedite allowance of the claims, Applicants have amended the claims to recite subject matter that the Patent Office acknowledges is enabled. Accordingly, Applicants believe the rejection is moot. Applicants therefore respectfully request withdrawal of the rejection of claims 1-8, 15-20, and 55-72 as failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph.

IV. The Rejection of Claims 1-8, 15-20, and 55-72 under the Judicially-Created Doctrine of Obviousness-Type Double Patenting Should be Withdrawn

Claims 1-8, 15-20, and 55-72 stand rejected under the judicially-created doctrine of obviousness-type double patenting as allegedly obvious variants of claims 1-33 of U.S. Patent No. 6,620,827 (“the ‘827 patent”).

In response, Applicants respectfully submit that no claim of the ‘827 patent provides motivation to select the specific subgenus of compounds recited by 1-8, 15-20, and 55-72.¹ As such, the ordinarily-skilled artisan would not regard the subject matter of claims 1-8, 15-20, and 55-72 as obvious variants of any claim of the ‘827 patent.

A. The Legal Standard

Under the judicially-created doctrine of obviousness-type double patenting, a claim must be patentably distinct from a *claim* of an already issued patent or pending application. *See General Food Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839 (Fed. Cir. 1992; emphasis added). If the claim at issue defines more than an obvious variation of the patented or pending claim, it is patentably distinct and rejection of the claim under the doctrine of obviousness-type double patenting is improper. *Id.*

To establish a proper obviousness-type double patenting rejection, the Examiner must show that the claim at issue is a “mere variation” of the patented or pending claim that

¹ Applicants note that claims 1-8, 15-20, and 55-62 relate to a particular genus of compounds, while claims 63-72 relate to compositions comprising such compounds. Thus, the compositions of claims 63-72 recite the genus of compounds recited by claims 1-8, 15-20, and 55-62, and thus Applicants address claims 1-8, 15-20, and 55-72 together.

“would have been obvious to those of ordinary skill in the relevant art.” *See In re Kaplan*, 229 U.S.P.Q. 678, 683 (Fed. Cir. 1986). In the analysis, the “patent disclosure may not be used as prior art;” instead, the Examiner must focus on the “subject matter that *has been protected*, not...something one may find to be disclosed by reading them” or the specification. *See General Food Corp.*, 23 U.S.P.Q.2d at 1846, quoting *In re Vogel*, 164 U.S.P.Q. 619, 622 (C.C.P.A. 1970) and *In re Boylan*, 157 U.S.P.Q. 370, 371 (C.C.P.A. 1968).

Moreover, a proper obviousness-type double patenting analysis parallels the obviousness analysis performed under 35 U.S.C. § 103(a). *See In re Braat*, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991) and M.P.E.P. § 804. Thus, arguments showing non-obviousness under 35 U.S.C. 103(a) may be made to show that a claim is not an obvious variant of a patented or pending claim. For example, Applicants may show that the claims at issue are not obvious variants of the patented claims by showing that such claims are not *prima facie* obvious variants of the patented claims. One way Applicants may show such non-obviousness is to show that the patented claims define a genus that does not suggest the species or subgenus recited by the claims at issue. *See In re Baird*, 29 U.S.P.Q.2d 1550 (Fed. Cir. 1994).

B. No Claim of the '827 Patent Suggests Selection of the Subgenus Recited by Claims 1-8, 15-20, and 55-72

The PTO argues that “the markush disclosed in the ['827] patent’s opening pages contains the phenyl ring being optionally substituted and many examples (such as examples 48 and 49) contain a substituted phenyl ring.” [Office Action, p. 7]. Applicants do not disagree with this description, but maintain that the specification of the '827 patent cannot be used to construct a proper obviousness-type double patenting rejection. Rather, as discussed above, an obviousness-type double patenting rejection is only concerned with *what is claimed* by the prior patent. None of the claims of the '827 patent recite a substituent for the central phenyl ring. As such, the claims of the '827 patent cannot possibly suggest selection of the particular substituents recited by the instant claims.

Further, neither the claims nor the specification of the '827 patent teaches or suggests the particular substituents defined by R³ as recited by, for example, claims 1, 63 and 73 of the instant application. In the present claims, R³ can be halogen, cyano, nitro or (C₁-C₈)alkoxy. No generic or specific compound disclosed by the '827 patent in either the claims or the specification comprises a halogen, cyano, nitro, and (C₁-C₈)alkoxy attached to an appropriate aromatic ring as recited by claim 1. Thus, for this additional reason, Applicants respectfully

submit that the obviousness-type double patenting rejection is improper and earnestly request its withdrawl.

CONCLUSION

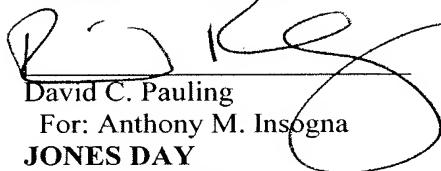
In light of the above amendments and remarks, Applicants respectfully request that the Examiner reconsider this application with a view towards allowance. The Examiner is invited to call the undersigned attorney at (650) 739-3949, if a telephone call could help resolve any items remaining prior to allowance.

Applicants believe that no fee is due in connection with this response beyond the fees associated with the Petition for Extension of Time. Should an additional fee be required, the Commissioner is hereby authorized to charge any such required fee(s) to Jones Day Deposit Account No. 50-3013 (Referencing No. 893053-999123).

By his signature below, Applicant hereby represents under Rule 34(b) of the Rules of Practice that this response is authorized by Amgen Inc.

Respectfully submitted,

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